

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY W. CUMMINGS and ROBERT CUMMINGS

Appeal No. 96-1415
Application No. 08/088,625¹

ON BRIEF

Before CALVERT, FRANKFORT and CRAWFORD, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 4, 7, 8, 10, 12, 14, 16, 17, 23 to 25, 33, 41 to 46, 54 to 56,

¹ Application for patent filed July 1, 1993. According to appellants, this application is a continuation of Application 07/780,619 filed October 23, 1991, now abandoned.

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60 to 63 and 66 to 69. The remaining claims in the application stand withdrawn from consideration under 37 CFR 1.142(b) as being drawn to nonelected species.

The subject matter in issue concerns a composite dressing applicable to a wound, and a method of treating a wound using a composite dressing. The claims on appeal are as set forth in the appendix to appellants' brief, except that (1) there are errors in claims 4, 25 and 33, and (2) claim 54 does not contain the additional language added by the amendment filed January 17, 1995.

The references applied to the appealed claims are:

Gilman (Gilman '001) 1986	4,600,001	Jul. 15,
Sims 27, 1987	4,638,796	Jan.
Gilman (Gilman '362) 1992	5,106,362	Apr. 21,

(filed Apr. 13, 1989)

An additional reference, of record, applied herein in rejections pursuant to 37 CFR 1.196(b) is:

Gilman (Gilman '510) 1991	5,056,510	Oct. 15,
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(filed Jan. 5, 1990)

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The claims on appeal stand rejected as follows²:

(1) Claims 1 to 4, 7, 8, 10, 12, 14, 16, 24, 25, 41 to 45, 54 to 56, 63 and 67, anticipated by Gilman '362 under 35 U.S.C.

§ 102(e), or unpatentable over Gilman '362 in view of Sims, under 35 U.S.C. § 103.

(2) Claims 1 to 4, 7, 8, 10, 12, 14, 17, 24, 25, 41 to 43, 54 to 56 and 63, unpatentable over Sims, under 35 U.S.C. § 103.

(3) Claims 23, 33 and 60 to 62, unpatentable over Gilman '362 in view of Sims and Gilman '001, under 35 U.S.C. § 103.

(4) Claims 46, 68 and 69, unpatentable under 35 U.S.C. § 103 over Gilman '362 alone, or in view of Sims³.

We have fully considered the record in light of the arguments presented in appellants' brief and reply brief, and

² In an Advisory Action dated February 23, 1995 (Paper No. 30), the examiner stated that the amendment (response) filed January 17, 1995, overcame a rejection of claim 54 under 35 U.S.C. § 112, second paragraph. Also, in a letter dated November 27, 1995 (Paper No. 39), the examiner indicated that in view of the terminal disclaimer filed June 22, 1995, a double patenting rejection of claims 1 to 4, 7, 8, 12, 16, 17, 23 to 25, 33, 41, 42, 54, 55 and 60 to 63 was withdrawn.

³ This was a new ground of rejection made in the examiner's answer.

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in the examiner's answer. As a result, we conclude that none of the rejections will be sustained, but that some of the appealed claims should be rejected pursuant to 37 CFR 1.196(b). Our reasons for these conclusions are discussed under separate headings below.

Rejection (1)

In explaining this rejection, the examiner stated that he considered the dressing component [sic: bottom of the contact component 12] of Gilman '362 to be "continuously planar," as claimed, notwithstanding the presence of one or more holes 22 therein, but alternatively, that it would have been obvious to utilize instead a permeable material such as disclosed by Sims' barrier 20. In response to appellants' argument that Gilman's dressing component and contact component are not "releasably attached directly to each other," as recited in claims 1, 43 and 54, the examiner noted Gilman's Figs. 7 and 10 to 12, in which dressing component 44 is directly attached to contact component 12 (Fig. 7) or absorbent layer 76 is releasably secured over vent sheet 68 (Figs. 10 to 12). Appellants argue in their reply brief that neither of these embodiments teaches a releasable, direct attachment.

We do not consider this rejection to be well taken. While the Fig. 7 embodiment of Gilman '362 does disclose the direct attachment of dressing component 44 to contact component 12 by adhesive 46, there is no disclosure that such attachment is releasable (see col. 4, lines 7 to 10), nor is it inherent that it would be. As for Gilman's Figs. 10 to 12 embodiment, the dressing component 76 is disclosed as being "releasably secured in place over the second vent sheet 68" (col. 5, lines 43 to 44), but there is no disclosure that it is directly attached to the vent sheet 68 or either of the other two parts 28, 84 of the contact component; in all probability, it would be secured to the patient by adhesive tape 32, as shown in Fig. 2. Absent an express or inherent disclosure of the claimed releasable direct attachment, claims 1, 43 and 54, and the claims dependent thereon, are not anticipated. See In re Schrieber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (claim not anticipated unless prior art reference discloses every limitation, either explicitly or inherently). As for claims 66 and 67, there is no disclosure in Gilman '362 of placing a second composite dressing over a wound over which a first contact component is

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held (claim 66), nor of placing a separated second dressing component over a first contact component remaining on the wound (claim 67). Thus, these claims are likewise not anticipated.

The Sims reference does not supply the noted deficiencies of Gilman '362, and therefore the rejection under § 103 is also not sustainable.

Rejection (2)

We are at somewhat of a loss to understand the basis of this rejection. The examiner acknowledges at page 7 of the answer that Sims' barrier (contact component) 20 "may not be directly attached to [the] absorbent layer as would be required to meet the present claims," but still appears to be of the opinion that such a modification of Sims would have been obvious, notwithstanding the lack of a secondary reference or other evidence thereof. On page 15 of the answer, the examiner refers to Sims' Fig. 3 and col. 3, lines 41 to 44, which state that a bandage (dressing component) 24 may be fixed to barrier 20 by a suitable adhesive bandage, but this is not a disclosure of direct attachment. There must be a factual basis to support a conclusion of obviousness. In re

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Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967),
cert. denied, 389 U.S. 1057 (1968). Lacking evidence of
obviousness, the rejection will not be sustained.

Rejection (3)

The Gilman '001 patent, cited as an additional reference
in this rejection, does not supply the deficiencies noted
above with regard to rejection (1). Therefore, this rejection
is not sustainable.

Rejection (4)

The claims to which this rejection applies, 46, 68 and
69, are dependent on claims 43, 66 and 67, respectively.
Since we have, with regard to rejection (1), not sustained the
rejection of those parent claims on the same references as
applied herein, we likewise will not sustain rejection (4).

Rejections Pursuant to 37 CFR 1.196(b)

(i) Claims 1 to 4, 7, 16, 17, 24, 25 and 41 to 43 are
rejected under 35 U.S.C. § 102(e) as anticipated by Gilman
'510. Figure 3 of this reference shows a composite dressing,
described as being a modification of the dressing shown in
Figs. 1 to 3 of the application which issued as Gilman '362,
comprising a generally planar contact component 102, 104 with

a continuously planar bottom side and a dressing (cover) component 106,126 directly attached to sheet 102 by a releasable seal, such as pressure-sensitive adhesive, to permit replacement of the cover component without removing the dressing (col. 5, lines 22 to 26; see also col. 4, lines 11 to 20). With regard to claims 4 and 7, which recite that the contact component is "configured" to permit placement of fasteners (claim 4), or to permit application of pressure (claim 7), it appears that any sheet, such as 102 of Gilman, would be "configured" to permit such actions, whether they were performed or not.

(ii) Claim 23 is rejected as unpatentable over Gilman '510 in view of Gilman '362. An important goal of Gilman '510 is to avoid removal of the dressing from the skin of the patient until healing is completed (see col. 7, lines 18 to 23), and Gilman '362 discloses that using a transparent sheet allows inspection of the wound without removing the dressing from the skin (col. 6, lines 12 to 16). In view of this teaching, it would have been obvious to make the contact component of Gilman '510 of transparent material.

(iii) Claim 33 is rejected under 35 U.S.C. § 103 as

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unpatentable over Gilman '510 in view of Gilman '001. To employ heat lamination as the particular means of releasably attaching the Gilman '510 contact and dressing components would be an obvious matter of design in selecting a particular known means of releasably attaching dressing components, as disclosed by Gilman '001.

(iv) Claim 46 is rejected under 35 U.S.C. § 103 as unpatentable over Gilman '510. In removing the cover component 106 of Gilman in order to replace it, once a corner of the cover sheet 126 was separated from the top surface 114 of sheet 102, it would have been obvious to hold down the sheet 102 with one or more fingers while separating the rest of sheet 126 therefrom, to insure that sheet 102 remained attached to the patient's skin.

(v) Claim 45 is rejected for failing to comply with 35 U.S.C. § 112, second paragraph. Parent claim 43 recites in its last two lines that the contact component remains in place over the wound, but claim 45 recites "if said first contact component remains on the wound" (emphasis added). This recitation in claim 45 is inconsistent with claim 43 in that it implies that the contact component may not be on the wound,

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while claim 43 recites that it is. As a result of this inconsistency, claim 45 is indefinite because its scope is not clear.

Conclusion

The examiner's decision to reject the appealed claims under 35 U.S.C. § 102(e) and/or § 103 is reversed. Claims 1 to 4, 7, 16, 17, 23 to 25, 33, 41 to 43 and 46 are rejected pursuant to 37 CFR 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings

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(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge))	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
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